

Response to Office Action dated July 28, 2008

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**REMARKS**

Claims 1-14 are currently pending. In the Office Action mailed July 28, 2008, the Examiner rejected claims 1-14 under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner next rejected claims 1-4, 9, 10, and 12-14 under 35 U.S.C. §102(b) as being anticipated by Harada et al. (U.S. Patent 5,522,466). The Examiner also rejected claims 1, 2, 4, 9, 10, 12, and 13 under 35 U.S.C. §102(b) as being anticipated by UK Patent Application '045 (UK Patent Application GB 2 171 045). Claims 5-8 and 11 stand rejected under 35 U.S.C. §103(a) has been unpatentable over Harada et al. or UK Patent Application '045 in view of Dunn (U.S. Patent 5,833,014).

The Examiner rejected claims 1, 5, 6 and 11 under 35 U.S.C. §112, second paragraph as being indefinite. Although Applicant does not necessarily agree with the Examiner's basis of rejecting these claims, Applicant has amended each of these claims to clarify that which is called for therein. Specifically, claim 1 has been amended to further define the position of the rolling element device and the interaction of the rolling element device with the hammer housing and the handle device. Applicant has amended claims 5, 6, 10, 11, and 12 to comport with the amendment to claim 1. Even though these amendments are believed to overcome each of the Examiner's indefiniteness rejections, Applicant requests the Examiner's consideration of the following remarks related to claim clarity and definiteness.

The Examiner rejected claim 5 as being "grammatically awkward and confusing, especially the last several lines" and for the use of the term "or". Although Applicant has amended claim 5 in an attempt to more clearly define that which is called for therein, MPEP §2173.02 clearly supports the claim as previously presented. As stated therein, "Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire." MPEP §2173.02 continues, "Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement." (Emphasis

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added). Such guidance seems equally applicable to the Examiner's confusion regarding the use of the term "area" in claim 10. As used therein, the term is clearly directed to defining a portion of the housing as compared to the geometric equation associated a measure of a surface.

With respect to the various rejections premised on Applicant's use of the term "or", the Examiner's attention is directed to MPEP §2173.05 (h)II. As stated therein, "Alternative expressions using 'or' are acceptable, such as 'wherein R is A, B, C, or D.'" (Emphasis added). Applicant has amended claims 5 and 6 to more clearly recite the alternative constructions defined therein. Furthermore, even though unnecessary, Applicant has eliminated the use of the term "or" in the claims by defining the alternative constructions with "at least one" language. For the reasons set forth above, Applicant believes claims 1-14 satisfy the applicable rules associated with clearly and succinctly defining a claimed invention.

The Examiner next rejected claim 1 under 35 U.S.C. §102(b) as being anticipated by Harada et al. As amended, claim 1 further defines the rolling element device and the relationship between the rolling element device and the hammer housing and the handle device for allowing generally uninterrupted movement therebetween in a working direction.

As described in the fourth paragraph of the Specification, under of the Description of the Related Art, Harada et al. is directed to a vibration dampening handle that is constructed to limit or dampen movement between the hammer unit and the handle. As described with respect to Fig. 2 of Harada et al., "when vibrations are generated from the tool body 1 during use in the direction Z, the elastic damper member 6 is elastically deformed in the direction Z ... [to] cause the inclined surfaces 13 and 15 of the elastic damper members 5 and 6 to move to each other so as to decrease the gaps between the inclined surfaces 13 and 15...." Col. 3, ll. 59-67.

Longitudinal displacement of the handle relative to the tool body, or displacement in the working direction of the tool, is limited, if not wholly eliminated, by the interaction of roller elements 4 with the generally curvilinear facing structures of damper portion 12 and damper member 6 of tool body. Simply, the system of Harada et al. is directed to isolating the handle from the vibration of the tool in a shock mount manner. As recited in claim 1, the present invention is

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directed to a class of tool that requires generally unfettered translation of the tool housing in a working direction relative to a handle device. Such a tool system is not disclosed or suggested in Harada et al. Accordingly, Applicant believes claim 1, and the claims that depend therefrom, are patentable over this reference.

The Examiner also rejected claim 1 under 35 U.S.C. §102(b) as being anticipated by UK Patent Application '045. As amended, claim 1 calls for, in part, a guide device having a rolling element device that is disposed between the hammer housing and the handle device and that maintains an alignment between the hammer housing and handle device for allowing generally uninterrupted movement in the working direction (A) and limiting lateral and rotational movement between the guide device and hammer housing in directions other than the working direction (A). The system of UK Patent Application '045 is more nearly associated with the handle vibration dampening system of Harada et al. than the presently claimed invention. That is, there is simply no structure in either of Harada et al. or UK Patent Application '045 that allows uninterrupted movement between working parts in a working direction and limits movement in non-working directions as called for in claim 1. Simply, the systems of Harada et al. or UK Patent Application '045 provide damped motion between the underlying tool and the handle in a generally indiscriminant manner. That is, the handles are generally offset or otherwise spaced from those portions of the tool that generate the working motion. The motion dampening systems of these references are constructed to allow isolated and damped movement of the handle relative to the tool body. As called for in claim 1, the system of the present invention requires relatively uninhibited movement between the respective parts in a working direction and no more than inhibited motion in non-working direction directions. The systems of the prior art do not disclose a tool constructed for such operation. As such, Applicant believes claims 1-14 are patentable thereover.

The addition of Dunn does nothing to overcome these shortcomings of Harada et al. and/or UK Patent Application '045. Dunn, unlike Harada et al. or UK Patent Application '045, is directed to a reciprocating tool handle, i.e. that portion of a device that cooperates with a

reciprocating tool. The Examiner maintains that “in view of teachings of Dunn ‘014, it would have been obvious to one skilled in the art to provide the devices of Harada et al. ‘466 or UK Patent Application ‘045 with the specifically claimed rolling elements and tracks for the guide arrangement in order to more effectively guide the elements.” Applicant respectfully disagrees.

In addition to the distinctions offered above with respect to Harada et al. and UK Patent Application ‘045, the system of Dunn is generally unrelated to the present invention. Whereas the system of Dunn is directed to allowing a user to manipulate a tool that is operated in a reciprocating manner, the present invention is directed to isolating a handle from a drive system of a tool that generates a reciprocating movement for driving tools -- such as those disclosed in Dunn. Simply, the device of Dunn is combinable or useable with drive systems such as those described in Harada et al. and/or UK Patent Application ‘045 provided such systems operate in a reciprocating manner.

As stated in MPEP §2141.01(a), “Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent [or application at issue] can provide a reason for combining the elements in the manner claimed.” Citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1397 (2007). MPEP §2141.01(a) further concludes that, “Thus a reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commanded itself to an inventor's attention in considering his or her invention as a whole.” Isolating an operators hand from the motion of a reciprocating driven tool does not logically commend itself to the problem of isolating an operators hand from the movement of the tool that generates the driving force. Accordingly, even in view of the distinctions offered above, Applicant does not believe Dunn is analogous art as required under MPEP §2141.01(a).

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Therefore, at least for the reasons set forth above, Applicant believes claims 1-14 are patentably distinct over the art of record. Accordingly, Applicant respectfully requests a notice of allowance of claims 1-14. Although no fees are believed due for entry and consideration of this paper, the Office is hereby authorized to charge any fees that may be deemed necessary for this or any subsequent paper, or credit any overpayment, to Deposit Account No. 50-1170. The Examiner is cordially invited to contact the undersigned if any of the above merits further discussion or if any other informal matters remain which may hinder or otherwise delay passage of this matter to issuance.

Respectfully submitted,

Timothy E. Newholm  
Registration No. 34,400

Date: October 22, 2008

Customer Account No.: 23598

BOYLE FREDRICKSON, S.C.  
840 North Plankinton Avenue  
Milwaukee, WI 53203  
Telephone: (414) 225-9755  
Facsimile: (414) 225-9753

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